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10/050,720	01/16/2002	Gerard Bonifacio	33900-95	7711

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Martin B. Pavane, Esq.  
Cohen, Pontani, Lieberman & Pavane  
Suite 1210  
551 Fifth Avenue  
New York, NY 10176

[REDACTED] EXAMINER

CHOP, ANDREA MARIE

[REDACTED] ART UNIT [REDACTED] PAPER NUMBER

3677

DATE MAILED: 08/11/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No. <b>10/050,720</b>	Applicant(s) <b>Bonifacio</b>
Examiner <b>Andrea Chop</b>	Art Unit <b>3677</b>

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

1)  Responsive to communication(s) filed on May 21, 2003.

2a)  This action is FINAL. 2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

### Disposition of Claims

4)  Claim(s) 14-53 is/are pending in the application.

4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 14-53 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are a)  accepted or b)  objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)  The proposed drawing correction filed on \_\_\_\_\_ is: a)  approved b)  disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)  The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

13)  Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)  All b)  Some\* c)  None of:

1.  Certified copies of the priority documents have been received.

2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

14)  Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

a)  The translation of the foreign language provisional application has been received.

15)  Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

1)  Notice of References Cited (PTO-892)

4)  Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_

2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)

5)  Notice of Informal Patent Application (PTO-152)

3)  Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_

6)  Other: \_\_\_\_\_

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**DETAILED ACTION**

***Response to Amendment***

1. In Applicant's amendment to the specification at Page 5, Paragraph 4, it appears that this amendment actually should have referenced Page 4, Paragraph 4; the amendment has been entered to the Page 4, Paragraph 4 text.

***Priority***

2. Receipt is acknowledged of papers submitted under 35 U.S.C. § 119, which papers have been placed of record in the file.

***Drawings***

3. It should be noted that the drawings have not yet been reviewed by a PTO draftsman. The drawings will be reviewed upon allowance of the application and Applicant will be apprised of their status accordingly.

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***Claim Rejections - 35 USC § 112***

4. Claims 18, 19, 24, 26, 29, 30 and 34-53 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As concerns Claims 18, 19, 41 and 42, last line, it appears that the sum of the angles should be 360 degrees and not 180 degrees as is claimed; the specification states that the sum is 360 degrees on Page 4.

As concerns Claims 29 and 30, "the free end" lacks antecedent basis.

As concerns Claims 34 and 51, last line, it appears that the axis of the hinge is actually parallel to or in the same plane as the mean plane of the decorative ring/part, and not transverse to it as is claimed.

As concerns Claims 35, 36, 52 and 53, these claims seem to imply that the entire unitary member lies in a plane transverse to the mean plane of the decorative ring, however, only a portion of the unitary member lies out of the mean plane of the decorative ring.

As concerns Claim 37, line 10, "suspension plane" is missing a modifier, such as --said--.

As concerns Claim 38, "the ring" lacks antecedent basis.

As concerns Claim 50, "the first end portion" lacks antecedent basis.

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***Claim Rejections - 35 USC § 101***

5. Claims 14, 16, 18, 19, 22, 31, 37, 39, 41, 42 and 45 and their dependent claims are rejected under 35 U.S.C. 101, since these claims positively recite a portion of the human body, and as such, are drawn to nonstatutory subject matter; Claims 14 and 37 recite "a first elongate substantially rectilinear portion extending at the first angle", the first angle having been defined with respect to the human body; Claims 16 and 39 define structure of an ear lobe; and Claims 18, 19, 22, 31, 41, 42 and 45 refer to the first angle, which was defined with respect to the human body. Applicant should amend the claims to remove positive recitation of the human body; such amended language can include functional phrases such as "adapted for", "attachable to", etc.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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7. Claims 14-17, 22-23, 25, 28, 31-35, 37, 39, 40, 45, 46 and 48-52 are rejected under 35 U.S.C. 102(b) as being anticipated by Riley et al. US 271,121.

Riley et al. shows (Fig. 4), a ring/part "a", and an attachment portion b'; with respect to the manner in which the claimed apparatus is intended to be employed, this does not patentably differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. Ex parte Masham, 2 USPQ2d 1647 (1987); and Riley et al. shows the claimed structural limitations. Riley et al. teaches the equivalence of having fastening means inside and outside of a ring part (Fig. 3 and Fig. 4). In regards to the various angles claimed, Riley et al. is considered to meet these limitations due to use of the language of "approximately".

8. Claims 14 and 16-53 are rejected under 35 U.S.C. 102(b) as being anticipated by Ireland US 3,933,009.

Ireland shows a decorative ring/part 12, and an attachment portion 22; with respect to the manner in which the claimed apparatus is intended to be employed, this does not patentably differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. Ex parte Masham, 2 USPQ2d 1647 (1987); and Ireland shows the claimed structural limitations. The first portion of the attachment portion is that portion of 22 between reference numerals 20 and 22 in Fig. 4 (that portion of 22 designated by reference numeral 30 in Fig. 3), the second portion is that portion of 22 designated by reference numeral 30 in Fig. 4, and the third portion is 32. In regards to Claim 35, portion 26 of the unitary member lies out of the mean

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plane of the decorative ring. In regards to the various angles claimed, Ireland is considered to meet these limitations due to use of the language of "approximately".

***Response to Remarks***

9. In response to Applicant's arguments regarding the nature of the angle of separation of the earlobe, it is pointed out to Applicant that positively reciting a portion of the human body is prohibited by 35 USC 101, since such claims are drawn to nonstatutory subject matter. Applicant cannot rely on the relationship of how Applicant's invention cooperates with a user's earlobe for patentability; Applicant can only positively recite various structural features of the earring with respect to one another. As always, functional language relating the earring to the earlobe is permitted as long as the language appropriately uses the phrases "adapted to" or "capable of" or similar non positive recitations, but it is pointed out that such functional recitations do not patentably differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations.

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10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

***Patent Customers Advised to FAX Communications to the USPTO***

11. In view of delays in mail delivery in recent days, we at the USPTO would like to encourage you to communicate with the USPTO via facsimile. **Facsimile transmissions may be used for correspondence as set forth in 37 CFR 1.6 such as: amendments, petitions for extension of time, authorization to charge a deposit account, an IDS, terminal disclaimers, a notice of appeal, an appeal brief, CPAs under 37 CFR 1.53(d), and RCEs.**

PTO Form 2038 should be used when authorizing payment by credit card; this form is maintained separate from the file to ensure confidentiality.

The USPTO has recently installed server software that enables us to automatically receive facsimile transmissions and route them to the appropriate groups. No special equipment is needed by our customers to use this system other than a regular facsimile machine.

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Each Technology Center has its own facsimile numbers associated with our server for Official replies to non-final Office actions and for Official replies to final Office actions. In addition, each Technology Center has a Customer Service Center on our server system and can answer any general application status questions you might have, can provide Examiner information and answer paper queries. The following is a list of all Official Facsimile numbers for Technology Center 3600:

TC 3600:

Before Final 703-872-9326

After Final 703-872-9327

Customer Service 703-872-9325

By using the Official Before Final and After Final numbers, our server system will automatically generate a return receipt that will include the number of pages received as well as the date and time the facsimile was received. Additionally, the return receipt will include an image of the received cover page. Applicants are advised to use the certificate of facsimile transmission procedures when submitting a reply to a non-final or final Office action by facsimile (see 37 CFR 1.6 and 1.8). Applicants are also advised to retain the return receipt in the event that the Office has no record of the facsimile submission, whether the facsimile submission is a reply to an Office action (37 CFR 1.8(b)), or a continued prosecution application under 37 CFR 1.53(d) (37 CFR 1.6(f)).

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**Note, however, the Office currently does not permit new application filings (other than a CPA under 37 CFR 1.53(d)), requests for reexamination, drawings, and certain correspondence set forth in 37 CFR 1.6(d) by facsimile.**

*Conclusion*

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrea Chop whose telephone number is (703) 305-6358.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-2168.

  
ANDREA CHOP  
PATENT EXAMINER  
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AMC  
August 6, 2003